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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,624	12/28/2000	Bertram Geck	00 P 9127 US	9439

7590 10/08/2003

Siemens Corporation
Attn: Elsa Keller, Legal Administrator
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 10/08/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,624

Applicant(s)

GECK ET AL.

Examiner

Md S Elahee

Art Unit

2697

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 09752630. Because, regarding claims 1-16, the claim descriptions are the same as the inventor's copending application having the application no. 09752630.

Claim Objections

3. Claims 2, 4, 8 and 10 are objected to because of the following informalities: regarding claims 2 and 8, 'obtaining first' should be 'obtaining said first'; regarding claim 4, 'obtaining second' should be 'obtaining said second'; regarding claim 10, 'obtain second' should be 'obtain said second'. Appropriate correction is required.

4. All abbreviations for the terms (e.g. PDN1, PDN2, BRI) should be written out for clarity.

Claim Rejections - 35 USC § 112

5. Claims 1, 3, 7 and 9 recite the limitation "the message exchange" in page 15, lines 8, 21 and page 16, line 17, 4, respectively. There is insufficient antecedent basis for this limitation in the claims.

Art Unit: 2697

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 7, 8, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Frech (U.S. Patent No. 4,907,259).

Regarding claims 1, 2, 7 and 8, Frech teaches generating a first call from PDN1 to PDN2 in the same BRI circuit (col.4, lines 60-67, col.5, lines 1-10, 53-54-67, col.6, lines 1-36)

Frech further teaches monitoring the message exchange on the D channel to obtain first Call Appearance information (col.3, lines 5-9, col.4, lines 60-67, col.5, lines 1-10, 53-54-67, col.6, lines 1-36).

Regarding claim 13, Frech teaches that the dialing means and the monitoring means are embodied in a switching module ("microprocessor") (fig.1, elements 110-140).

Regarding claim 15, Frech teaches the dialing means and the monitoring means are embodied in an application specific integrated circuit (fig.1; col.3, lines 33-47).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2697

9. Claims 3-6, 9-12, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frech (U.S. Patent No. 4,907,259) and in view of Brown et al. (U.S. Patent No. 5,600,654).

Regarding claims 3-6 and 9-12, Frech fails to teach “putting the first call on hold”. Brown teaches putting the first call on hold (col.4, lines 32-51). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Frech to allow putting the first call on hold as taught by Brown. The motivation for the modification is to have doing so in order to incorporate the steps of identifying the call appearance values in Frech's system in order to have better instructions for configuring the call appearance values so that customer can follow those steps to identify the call appearance values on his/her CPE by himself/herself besides having them programmed.

Frech further teaches generating a second call from PDN1 to PDN2 in the same BRI circuit (col.1, lines 45-51, col.4, lines 60-67, col.5, lines 1-10, 53-53-67, col.6, lines 1-36)

Frech further teaches monitoring the message exchange on the D channel to obtain second Call Appearance information (col.1, lines 45-51, col.3, lines 5-9, col.4, lines 60-67, col.5, lines 1-10, 53-53-67, col.6, lines 1-36).

Regarding claims 5, 6, 11 and 12, Frech fails to teach “putting the call on hold”. Brown teaches putting the call on hold (col.4, lines 32-51). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Frech to allow putting the call on hold as taught by Brown. The motivation for the modification is to have doing so in order to incorporate the steps of identifying the call appearance values in Frech's system in order to have better instructions for configuring the call appearance values so that customer can follow

Art Unit: 2697

those steps to identify the call appearance values on his/her CPE by himself/herself besides having them programmed.

Frech further teaches generating another call (col.1, lines 45-51, col.4, lines 60-67, col.5, lines 1-10, 53-53-67, col.6, lines 1-36, col.8, lines 51-55)

Frech further teaches monitoring the D channel until the generated call results in a busy signal (col.1, lines 45-51, col.3, lines 5-9, col.4, lines 60-67, col.5, lines 1-10, 53-53-67, col.6, lines 1-36).

Regarding claim 17, Frech teaches that the dialing means, the monitoring means, the capture means, the holding means, and the repeating means are embodied in a switching module ("microprocessor") (fig.1, elements 110-140).

Regarding claim 19, Frech teaches the dialing means, the monitoring means, the capture means, the holding means, and the repeating means are embodied in an application specific integrated circuit (fig.1; col.3, lines 33-47).

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frech (U.S. Patent No. 4,907,259) and in view of Johnson et al. (U.S. Patent No. 6,141,406).

Regarding claim 15, Frech fails to teach that the dialing means, the monitoring means are embodied in a field programmable gate array. Johnson teaches that the dialing means, the monitoring means are embodied in a field programmable gate array (col.14, lines 50-61, col.15, lines 29-55). Thus, it would have been obvious to one of ordinary skill in the art to modify Frech to allow the dialing means, the monitoring means to be embodied in a field programmable gate array as taught by Johnson. The motivation for the modification is to incorporate the equipments

Art Unit: 2697

mentioned above in Frech's system in order to have a system with better equipments to support testing and configuring the call appearance values.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frech (U.S. Patent No. 4,907,259) and in view of Hughes-Hartogs (U.S. Patent 5,854,829).

Regarding claim 16, Frech fails to teach that the dialing means and the monitoring means are embodied in firmware in a PBX switch. Hughes-Hartogs teaches that the dialing means, the monitoring means, the capture means, the holding means and the repeating means are embodied in firmware in a PBX switch (fig.1, PBX 7). Thus, it would have been obvious to one of ordinary skill in the art to modify Frech to allow the dialing means and the monitoring means to be embodied in firmware in a PBX switch as taught by Johnson. The motivation for the modification is to incorporate the equipments mentioned above in Frech's system in order to have a system with better equipments to support testing and configuring the call appearance values.

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frech (U.S. Patent No. 4,907,259) and in view of Brown et al. (U.S. Patent No. 5,600,654) and further in view of Johnson et al. (U.S. Patent No. 6,141,406).

Regarding claim 18, Frech in view of Brown fails to teach that the dialing means, the monitoring means, the capture means, the holding means are embodied in a field programmable gate array. Johnson teaches that the dialing means, the monitoring means, the capture means, the holding means are embodied in a field programmable gate array (col.9, lines 58-67, col.10, lines 1-4, col.14, lines 50-61, col.15, lines 29-55). Thus, it would have been obvious to one of ordinary skill in the art to modify Frech in view of Brown to allow the dialing means, the monitoring

Art Unit: 2697

means, the capture means, the holding means to be embodied in a field programmable gate array as taught by Johnson. The motivation for the modification is to incorporate the equipments mentioned above in Frech's system in order to have a system with better equipments to support testing and configuring the call appearance values.

13. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frech (U.S. Patent No. 4,907,259) and in view of Brown et al. (U.S. Patent No. 5,600,654) and further in view of Hughes-Hartogs (U.S. Patent 5,854,829).

Regarding claim 20, Frech in view of Brown fails to teach that the dialing means, the monitoring means, the capture means, the holding means and the repeating means are embodied in firmware in a PBX switch. Hughes-Hartogs teaches that the dialing means, the monitoring means, the capture means, the holding means and the repeating means are embodied in firmware in a PBX switch (fig.1, PBX 7). Thus, it would have been obvious to one of ordinary skill in the art to modify Frech in view of Brown to allow the dialing means, the monitoring means to be embodied in a field programmable gate array as taught by Johnson. The motivation for the modification is to incorporate the equipments mentioned above in Frech's system in order to have a system with better equipments to support testing and configuring the call appearance values.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brady (U.S. Patent 5,937,049) teaches service bureau caller ID collection with ISDN BRI. Brown et al. (U.S. Patent 5,309,028) teach call coverage arrangement in an ISDN switching system.

Art Unit: 2697

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on (703) 305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

M. E.

MD SHAFIUL ALAM ELAHEE
September 24, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

